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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/028,325

12/21/2001

J. Dean Cole

31181.27

6083

27683

7590

05/25/2004

HAYNES AND BOONE, LLP
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EXAMINER

PRIDDY, MICHAEL B

ART UNIT

PAPER NUMBER

3732

DATE MAILED: 05/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/028,325

Applicant(s)

COLE, J. DEAN

Examiner

Michael B Priddy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-21 and 23-38 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13-16 is/are allowed.
- 6) ☒ Claim(s) 11, 12, 17-21 and 23-38 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

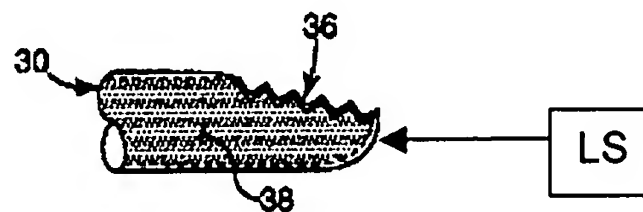
In the Office Action mailed 02/10/2004 the Examiner indicated claims 11, 17, 23 and 26 contained allowable subject matter. After an updated search and further consideration, a new prior art rejection has been applied below. The Examiner sincerely regrets any inconvenience to Applicant or Applicant's Representative. Since Applicant has not had the opportunity to address this new rejection, the finality of the Official Action mailed 02/10/2004 is hereby withdrawn.

Claim Rejections - 35 USC § 102

Claims 11, 12, 18-21, 23-29 and 38 are rejected under 35 U.S.C. 102(e) as being anticipated by Peters (U.S. 6,663,628). Peters teaches a reaming head, comprising: a body 12 having a longitudinal axis and a perpendicular axis perpendicular to the longitudinal axis; an outer surface 38 disposed on a first side of the body, a truncated surface 34 disposed on a second side of the body; a cutting element 36 positioned in said truncated surface 34; a first end of the perpendicular axis intercepting at least a portion of the outer surface 38, and a second end of the perpendicular axis intercepting at least a portion of the truncated surface 34; wherein said cutting element 36 comprises a single, serrated blade extending in substantial alignment with said longitudinal axis; further including a rounded leading surface LS adjacent said outer surface; wherein said outer surface extends over an arc of a majority of a circumference of said body; wherein said outer surface is substantially uninterrupted; further

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comprising a lumen 32 capable of receiving a guide wire. It should be noted that Peters predates the actual filing date of the present application but post-dates the filing date of the 09/619,189 Application. However, the subject matter of the present claims was not disclosed in the '189 application and the effective date of said subject matter is therefore the same as the actual filing date of the present application (12/21/2001).

**Fig. 3**

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17, 30-32, 34, 26, 35-37 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peters. Peters, as set forth above, teaches all of the limitations of the present invention except said outer surface extends over an arc of at least 240° of a circumference of said body. It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the outer surface of Peters such that it extended over an arc of at least 240° of a circumference of said body, since it has

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been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Allowable Subject Matter

Claims 13-16 are allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael B. Priddy whose telephone number is (703) 308-8620. The examiner can normally be reached on Mon.-Fri. 8 a.m. - 5 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (703) 308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael B. Priddy

Michael B. Priddy
May 5, 2004